

### **REMARKS**

Applicant respectfully requests reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks.

Claims 1 and 3-38 are pending in the application, with claims 1, 9, 11, and 21 being independent. Claims 1, 9, 11, and 21 have been amended. No new matter has been added.

### **Statement of Substance of Interview**

Initially, Applicant wishes to thank the Examiner for conducting telephone interviews and communications with Applicant's representative, on January 24, 2007, January 30, 2007, and January 31, 2007, respectively.

During the interviews, the independent claims were discussed, as was the finality of the pending Office Action. In addition, various proposed claim amendments were discussed. The Examiner suggested clarifying particular language in the independent claims, but made no other substantive comments in regard to the claims. Without conceding the propriety of the rejections and in the interest of expediting allowance of the application, the independent claims 1, 9, 11, and 21 are amended herein for purposes of clarification as discussed during the interview. All of the pending claims are believed to be allowable over the cited documents for the reasons discussed during the interview and outlined below.

Also, the Examiner took the position that the outstanding Office Action was properly made final. Applicant disagrees for the reasons discussed below and requests withdrawal of the finality of the Office Action.

### **Finality of Pending Office Action**

The Examiner and Applicant's representative discussed the finality of the pending Office Action, dated December 15, 2006, during the interviews. The Examiner took the position that finality was justified on the grounds that: 1) the amendments made to the claims as of the prior Response were generally insignificant; 2) no new art had been cited in the rejections against the claims relative to the prior Office Action; and 3) technology center policy generally permits finality in such situations. Applicant respectfully disagrees with the finality of the Office Action.

In preparing a response to the previous Office Action, dated June 23, 2006, Applicant's representative conducted an interview with the Examiner. During the interview, Applicant's representative proposed several amendments to the claims. While agreement was not reached, the Examiner appeared receptive to Applicant's arguments and amendments, but indicated that the amendments would raise new issues that would require further consideration and would, therefore not be entered after final. (See the Statement of Substance of Interview accompanying Applicant's September 22, 2006 Response.) From the Examiner's comments, Applicant's representative understood that the amendments presented in the September 22, 2006 would not be entered without filing a request for continued examination (RCE). Accordingly, Applicant submitted an RCE along with the September 22, 2006 Amendment, amending independent claims 1, 9, 11 and 21.

Applicant submits that the outstanding Office Action, being the first action following filing of an RCE and Amendment, should not have been made final. MPEP 706.07(b) provides that:

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to **the same invention claimed in the earlier application**, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. [Emphasis Added.]

Also, in the patent law, an Applicant's invention is defined by the claims of the application. Since an invention is defined by the claims, if the claims change so must the invention to which the claims are drawn.

In this case, Applicant substantively amended the independent claims in the Response accompanying the RCE on September 22, 2006. For example, independent claim 1 was amended to recite that "the second call transmit[s] an audible message to the second telephone station." Since the claims changed, so to did the invention being claimed. Thus, the amended claims cannot be said to be "drawn to the same invention" as those presented prior to the amendment. Accordingly, Applicant respectfully requests that the finality of the Office Action be withdrawn.

### **Objections to the Claims**

Claim 9 is objected to due to informalities. Specifically, the wording "The method of claim 1," as appeared previously in claim 9, was not properly deleted by way of strikethrough text (page 3 of Office Action).

Claim 9 has been amended as indicated above to show proper deletion of the objected-to wording by way of strikethrough text. Applicant believes that such

amendment to independent claim 9 fully addresses the objection raised by the Examiner and respectfully requests that such objection be withdrawn.

### **§ 103 REJECTIONS**

**Claims 1, 3-5, 8, 10, 11, 13-16, 21-25, 28, 32-35, and 37 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,233,325 B1 (Frech) in view of U.S. Patent No. 6,301,250 B1 (Henningson).** This rejection is respectfully traversed. Nevertheless, without conceding the propriety of the rejection, independent claims 1, 11, and 21 have been amended for clarification.

**Independent claim 1** is directed to a method for providing audible and visual caller information for calls routed from a first telephone station to a second telephone station via a switching network including, *inter alia*, “placing a first telephone call from the first telephone station directed to the second telephone station via a first service switching point of the switching network,” “replacing a telephone directory number associated with the services node with a telephone directory number associated with the first telephone station,” “determining information associated with the first telephone station from a database stored at a services control point,” “audibly communicating the information associated with the first telephone station to the second telephone station,” and “visually communicating the telephone directory number of the first telephone station that replaced the telephone directory number associated with the services node to the second telephone station.” Thus, independent claim 1 as presently presented is directed to providing both audible and visual information regarding a first telephone station to a second telephone station.

The Examiner asserts that it would have been obvious to modify Frech in view of the teachings of Henningson, in order to arrive at the subject matter recited by claim 1 (page 6 of Office Action). However, the § 103 rejection of claim 1 is improper at least because: 1) there can be no motivation to combine the teachings of Frech and Henningson as suggested in the Office Action, because Frech teaches away from any such modification, and 2) even if, for the sake of argument the combination was proper, the combination still lacks features of the independent claims.

**Proposed Modification of Frech is Impermissible**

One of ordinary skill in the art would not have been motivated to combine the teachings of Frech and Henningson, because Frech expressly teaches away from such a combination. To support a *prima facie* obviousness rejection, “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP 2141.02(VI). Further, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP 2143.01(V).

In the instant case, Frech teaches away from the proposed combination. Specifically, Frech is directed to providing an audible announcement of a calling party’s name to the intended recipient, and is particularly concerned with avoiding the need for visual display equipment for caller identification. For example, Frech provides that:

A disadvantage of regular calling number/name identification is that it requires special equipment to display the number or name at any receiving telephone station. This disadvantage is overcome in accordance with

the teachings of U.S. Pat. No. 4,899,358 (the '358 patent) which discloses arrangements for announcing a name or number for an incoming call, and U.S. Pat. No. 5,007,076 (the '076 patent) which discloses arrangements for announcing a name or number for a waiting call to a party who has call waiting service. The announcement is receivable on any telephone instrument without requiring the special display equipment.

(Col. 1, lines 25-35 of Frech) (Emphasis added.).

Thus, Frech considers the requirement of special equipment in order to display a number or name at a receiving telephone station to be a distinct disadvantage. In turn, Frech is exclusively directed to means and methods for audibly announcing caller information to a call recipient. For this reason, Frech teaches directly away from “audibly communicating the information associated with the first telephone station to the second telephone station” **and** “visually communicating the telephone directory number of the first telephone station that replaced the telephone directory number associated with the services node to the second telephone station,” as presently recited in Applicant’s independent claim 1. Accordingly, the combination of Frech in view of Henningson is impermissible, and any rejection based on this combination should be withdrawn.

#### **Frech and Henningson Lack Features of the Independent Claims**

Even assuming, for the sake of argument, that Frech could be modified in view of the teachings of Henningson, the proposed combination still lacks features of each of the independent claims. To make an obviousness rejection under § 103 “the prior art reference (or references when combined) must teach or suggest all the claim limitations” and “[t]he teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, and not based on applicant's disclosure." In this case, none of the cited references discloses or suggests "audibly communicating the information associated with the first telephone station to the second telephone station" and "visually communicating the telephone directory number of the first telephone station that replaced the telephone directory number associated with the services node to the second telephone station," as presently recited in Applicant's independent claim 1. Accordingly, the combination of references cannot be said to disclose such features.

As discussed above, Frech is directed to audibly announcing a name or other information regarding a calling party to a party being called, but has as its purpose to avoid additional visual display equipment. Thus, Frech does not disclose providing both audible and visual information regarding a first telephone station to a second telephone station.

Henningson fails to cure the deficiencies of Frech. Henningson is directed to a call forwarding system, wherein a calling party can be provided audible or visual display pertaining to use (i.e., management) of the call forwarding service. In particular, Henningson provides that:

For subscriber DTMF access, a local number (an Administration Number) is provided in each calling area for subscribers to dial in order to listen to or make changes to their Service Profiles associated with their FindMe<sup>SM</sup> service. Of course, if a screen phone or similar adaptation is used, the subscriber could be provided a visual display of his or her service as well. Likewise, a calling party could be prompted for information and provided announcements in the form of visual displays when attempting to connect a call to a subscriber.

(Col. 7, lines 54-63 of Henningson).

However, Henningson fails to teach or suggest “audibly communicating the information associated with the first telephone station to the second telephone station” **and** “visually communicating the telephone directory number of the first telephone station that replaced the telephone directory number associated with the services node to the second telephone station,” as presently recited in Applicant’s independent claim 1. Therefore, even if Frech and Henningson could be permissibly combined (which they cannot), the combination still lacks features of Applicant’s claim 1.

For at least the foregoing reasons, as well as for those reasons argued previously in prosecution, Applicant asserts that the § 103 rejection of independent claim 1, as presently presented, is unsupported and should be withdrawn. Applicant further asserts that claim 1 as presently presented is allowable.

**Independent claims 11 and 21** are directed to an advanced intelligent network and to a system for audibly and visually announcing/providing information regarding a first telephone station to a second telephone station, respectively, and each is allowable for reasons similar to those discussed above with respect to independent claim 1.

**Dependent claims 3-5, 8, 10, 13-16, 22-25, 28, 32-35, and 37** depend from one of independent claims 1, 11, and 21, and each is allowable by virtue of its dependency from the respective base claim, as well as for the additional features that it recites.

**Claims 6 and 35 were rejected under 35 U.S.C. § 103(a) as being obvious over Frech and Henningson, in view of U.S. Patent No. 5,850,435 (Devillier).** This rejection is respectfully traversed.



Claims 6 and 35 depend from one of independent claims 1 and 21 and, therefore, include all of the features of their respective base claims.

Devillier was cited on page 10 of the Office Action for its alleged teaching of “connecting the calling party with the voice mail of the second telephone station,” but fails to remedy the deficiencies of Frech and Henningson noted above with respect to independent claims 1 and 21. In particular, Devillier fails to disclose or suggest “audibly communicating the information associated with the first telephone station to the second telephone station,” and “visually communicating the telephone directory number of the first telephone station that replaced the telephone directory number associated with the services node to the second telephone station.”

Accordingly, claims 6 and 35 are allowable by virtue of their dependency from claims 1 and 21, respectively, as well as for the additional features that they recite.

**Claim 7 was rejected under 35 U.S.C. § 103(a) as being obvious over Frech and Henningson, in view of U.S. Patent No. 5,481,602 (Griffiths).** This rejection is respectfully traversed.

Claim 7 depends from independent claim 1 and, therefore, includes all of the features of that claim.

Griffiths was cited on pages 10 and 11 of the Office Action for its alleged teaching of “playing ringing to the calling party until a timer expires,” but fails to remedy the deficiencies in Frech and Henningson noted above with respect to independent claim 1. In particular, Griffiths fails to disclose or suggest “audibly communicating the information associated with the first telephone station to the second telephone station,”

and “visually communicating the telephone directory number of the first telephone station that replaced the telephone directory number associated with the services node to the second telephone station.”

Accordingly, claim 7 is allowable by virtue of its dependency from claim 1, as well as for the additional features that it recites.

**Claims 9, 17, and 27 were rejected under 35 U.S.C. § 103(a) as being obvious over Frech and Henningson, in view of U.S. Patent No. 6,141,409 (Madoch).** This rejection is respectfully traversed.

**Independent claim 9** as presently presented recites a method for providing audible and visual caller information for calls routed from a first telephone station to a second telephone station via a switching network including, *inter alia*, “placing a first telephone call from the first telephone station directed to the second telephone station via a first service switching point of the switching network,” “replacing a telephone directory number associated with the services node with a telephone directory number associated with the first telephone station,” “determining information associated with the first telephone station from a database stored at a services control point,” “audibly communicating the information associated with the first telephone station to the second telephone station,” and “visually communicating the telephone directory number of the first telephone station that replaced the telephone directory number associated with the services node to the second telephone station ....”

As discussed above, Frech and Henningson, whether considered alone or in combination, fail to teach or suggest at least the foregoing subject matter of claim 9 as

presently presented. Furthermore, any modification to Frech as asserted by the Examiner (page 11 of Office Action) is impermissible as discussed above.

Madoch was cited on page 11 of the Office Action for its alleged teaching of “at the service point, querying a second service control point for the originating number,” but Madoch fails to remedy the deficiencies in Frech and Henningson noted above with respect to independent claim 1. In particular, Madoch fails to disclose or suggest “audibly communicating the information associated with the first telephone station to the second telephone station,” and “visually communicating the telephone directory number of the first telephone station that replaced the telephone directory number associated with the services node to the second telephone station ...”

Accordingly, independent claim 9 is allowable.

**Claims 17 and 27** depend from one of independent claims 11 and 21 and, therefore, include all of the features of their respective base claims. For reasons analogous to those discussed immediately above in regard to independent claim 9, Madoch fails to cure the deficiencies of Frech and Henningson with respect to the subject matter respectively recited by independent claims 11 and 21.

Accordingly, claims 17 and 27 are allowable by virtue of their dependency from claims 11 and 21, respectively, as well as for the additional features that they recite.

**Claim 12 was rejected under 35 U.S.C. § 103(a) as being obvious over Frech in view of U.S. Patent No. 6,404,875 B2 (Malik).** This rejection is respectfully traversed.

Claim 12 depends from independent claim 11 and, therefore, includes all of the features of that claim.

Malik was cited on page 12 of the Office Action for its alleged teaching of “retrieving at least more than 15 characters of data from the database,” but fails to remedy the deficiencies in Frech and Henningson noted above with respect to independent claim 11. In particular, Malik fails to disclose or suggest, at the very least, “...audibly announcing the information associated with the first telephone station to the second telephone station,” and “visually communicating the telephone directory number associated with the first telephone station that replaced the telephone directory number associated with the identified services node to the second telephone station.”

For the reasons discussed above, as well as for those reasons argued previously in prosecution, claim 12 is allowable by virtue of its dependency from claim 11, as well as for the additional features that it recites.

**Claims 18-20 and 29-31 were rejected under 35 U.S.C. § 103(a) as being obvious over Frech and Henningson, in view of U.S. Patent No. 6,400,809 B1 (Bossemeyer, Jr.).** This rejection is respectfully traversed.

Claims 18-20 and 29-31 depend from one of independent claims 11 and 21 and, therefore, include all of the features of the respective base claim.

Bossemeyer, Jr. was cited on page 14 of the Office Action for its alleged teaching of “converting textual caller information to text-to-speech format by means of pre-processor,” but fails to remedy the deficiencies in Frech and Henningson as noted above with respect to independent claims 11 and 21. In particular, Bossemeyer, Jr. fails to

disclose or suggest “audibly announcing the information associated with the first telephone station to the second telephone station,” and “visually communicating the telephone directory number associated with the first telephone station that replaced the telephone directory number associated with the identified services node to the second telephone station.”

Accordingly, claims 18-20 and 29-31 are allowable by virtue of their dependency from claims 11 and 21, respectively, as well as for the additional features that they recite.

**Claim 23 was rejected under 35 U.S.C. § 103(a) as being obvious over Frech and Henningson, in view of U.S. Patent No. 6,363,411 B1 (Dugan).** This rejection is respectfully traversed.

Claim 23 depends from independent claim 21 and, therefore, includes all of the features of that claim.

Dugan was cited on page 15 of the Office Action for its alleged teaching that “DTMF tones is detected in response to system prompts,” but fails to remedy the deficiencies in Frech and Henningson noted above with respect to independent claim 21. In particular, Dugan fails to disclose or suggest a system that “communicates an audible announcement of said information to said second telephone station,” and “visually communicates said telephone directory number associated with said first telephone station that replaced said telephone directory number associated with said serviced node via said second service switching point.”

Accordingly, claim 23 is allowable by virtue of its dependency from claim 21, as well as for the additional features that it recites.

**Claims 26 and 38 were rejected under 35 U.S.C. § 103(a) as being obvious over Frech and Henningson, in view of U.S. Patent No. 5,812,533 (Cox).** This rejection is respectfully traversed.

Claims 26 and 38 depend from one of independent claims 1 and 21 and, therefore, include all of the features of the respective base claim.

Cox was cited on page 16 of the Office Action for its alleged teaching of “retrieving at least 50 characters of information from the database,” but fails to remedy the deficiencies in Frech and Henningson noted above with respect to independent claims 1 and 21. In particular, Cox fails to disclose or suggest “audibly communicating the information associated with the first telephone station to the second telephone station,” and “visually communicating the telephone directory number of the first telephone station that replaced the telephone directory number associated with the services node to the second telephone station.”

Accordingly, claims 26 and 38 are allowable by virtue of their dependency from claims 1 and 21, respectively, as well as for the additional features that they recite.

**Claim 36 was rejected under 35 U.S.C. § 103(a) as being obvious over Frech and Henningson, in view of Devillier and Griffiths** This rejection is respectfully traversed.

Claim 36 depends from independent claim 21 and, therefore, includes all of the features of that claim.

As discussed above, both Devillier and Griffiths fail to remedy the deficiencies in Frech and Henningson noted above with respect to independent claim 21. In particular, Devillier and Griffiths both fail to disclose or suggest a system that “communicates an audible announcement of said information to said second telephone station,” and “visually communicates said telephone directory number associated with said first telephone station that replaced said telephone directory number associated with said serviced node via said second service switching point.”

Accordingly, claim 36 is allowable by virtue of its dependency from claim 21, as well as for the additional features that it recites.

### **CONCLUSION**

For at least the foregoing reasons, claims 1 and 3-38 are in condition for allowance. Applicant respectfully requests reconsideration and withdrawal of the rejections and an early notice of allowance. The amendments herein could not have previously been presented because Applicant honestly believed that the claims as previously presented were patentable over the cited documents. Accordingly, the instant claim amendments and additions should be entered and considered after final.

If any issue remains that would prevent allowance of this case, **Applicant**  
**requests that the Examiner contact the undersigned attorney to resolve the issue.**

Respectfully submitted,

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